



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/394,023	09/10/1999	BELISARIO DAVILA ALANIS	041-468-L	3630
27201	7590	03/09/2004	EXAMINER	
UNISYS CORPORATION OFFICE OF GENERAL COUNSEL 10850 VIA FRONTERA M/S 1000 SAN DIEGO, CA 92127			KISS, ERIC B	
			ART UNIT	PAPER NUMBER
			2122	16
			DATE MAILED: 03/09/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

PPG

Office Action Summary	Application No. 09/394,023	Applicant(s) ALANIS, BELISARIO DAVILA	
	Examiner Eric B. Kiss	Art Unit 2122	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2003.
- 2a) ☐ This action is **FINAL**.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4,8,12,14,16 and 17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4,8,12,14,16 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 November 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 2122

DETAILED ACTION

1. The reply filed December 10, 2003, has been received and entered. Claims 1, 4, 8, 12, 14, 16, and 17 are pending.

Oath/Declaration

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56.

Applicant has initially acknowledged the duty to disclose information under 37 CFR 1.56, but Applicant appears to have selectively narrowed the scope of 37 CFR 1.56 with the subsequent statement:

...and which is material to the examination of this application, namely, information where there is a substantial likelihood that a reasonable examiner would consider it important in deciding whether to allow the application to issue as a patent...

Drawings

3. Figures 1A, 1B, 1C, 1D, 2, 3, 4, and 5, should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).

Art Unit: 2122

4. The drawings are objected to because Fig. 6 illustrates a two-dimensional array inconsistent with the disclosure on pp. 24-25. Specifically, the Examiner believes that two typographical errors appear in Fig. 6:

- a) the n^{th} column of the array should presumably be labeled --8191-- instead of "8192". That is, 8,193 columns are illustrated (counting column 0) instead of the disclosed 8,192 columns
- b) the descriptive label "ARRAY BUFFER [0:47, 0:8192]" in Fig. 6 should presumably read --ARRAY BUFFER [0:47, 0:8191]-- (see the discussion above).

5. The drawings are objected to because reference "A" (upper-left corner) in Fig. 7c should apparently read --I--.

6. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

7. The disclosure is objected to because of the following informalities:

- a) "1D" on p. 7, in line 4, should presumably read --1B--
- b) the title should be removed from the Abstract

Art Unit: 2122

- c) “[0:47, 0:8192]” on p. 24, in line 33, should presumably read --[0:47, 0:8191]--
(see the discussion above in the objection to Fig. 6).
- d) “precedes the” on p. 26, in line 21, should presumably read --proceeds to--.

Appropriate correction is required.

Response to Amendment

8. Applicant's amendments to claims 1, 4, 8, and 12, appropriately address the rejection of claims 1, 4, 8, and 12 under 35 U.S.C. §112, first paragraph, as detailed in the office action mailed July 14, 2003 (Paper No. 10). Accordingly, this rejection is withdrawn in view of Applicant's amendments.

Response to Arguments

9. Applicant's arguments, see pp. 25, 26, 29, and 30, filed December 10, 2003, with respect to limitation (b) in each of claims 1 and 4 have been fully considered and are persuasive. The rejection of claims 1 and 4 under 35 U.S.C. §102 (a) (e) has been withdrawn.

10. Although Applicant has not provided arguments specifically traversing the rejections of claims 8, 12, and 14, the Examiner has reevaluated the positions taken in the previous Office actions, specifically in regard to the statements of Official Notice taken in rejecting claims 8, 12,

Art Unit: 2122

and 14. Upon further review, the Examiner has concluded that, while Applicant has failed to seasonably challenge these statements of Official Notice, and it can be taken as admitted prior art that it is old and well-known in the art that a processor has the means to allocate memory, in either a first and/or second two-dimensional buffer array. Sufficient and compelling evidence does not exist for modifying the applied prior art in view of the Official Notice to arrive at the claimed invention, as recited in claims 8, 12, and 14. Accordingly, the rejections of claims 8, 12, and 14, under 35 U.S.C. §103(a), have been withdrawn.

Claim Objections

11. Claim 8 is objected to because of the following informalities: “appropriately proper” should presumably read --proper--. Appropriate correction is required.

12. Claim 12 is objected to because of the following informalities: “of” in line 1 of limitation (d) appears to be unnecessary. Appropriate correction is required.

13. Claim 16 is objected to because of the following informalities: a semicolon appears before the end of limitation (d) and a semicolon is missing from the end of limitation (h). Appropriate correction is required.

14. Claim 17 is objected to because of the following informalities: a semicolon appears before the end of limitations (dn7) and (dn9). Appropriate correction is required.

Claim Rejections - 35 USC § 112

15. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

16. Claims 1, 4, 12, and 14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As per claim 1, the disclosure provides support for choosing a one-dimensional array or dual two-dimensional arrays (see for example, Figs. 7B and 7C) but does not appear to support selection between single or dual two-dimensional array means as recited in limitation (b).

As per claim 4, the disclosure provides support for choosing a one-dimensional buffer array or two 384KB two-dimensional buffer arrays (see for example, Figs. 7B and 7C) but does not appear to support selecting a buffer array size which most closely approximates the recognized number of bytes to be downloaded.

As per claim 12, the disclosure provides support for choosing a one-dimensional array or dual two-dimensional arrays (see for example, Figs. 7B and 7C) but does not appear to support selection between single or double two-dimensional array means as recited in limitation (e).

Art Unit: 2122

As per claim 14, the disclosure provides support for using two 384KB two-dimensional arrays (see for example, Figs. 7B and 7C) but does not appear to support other selected sizes of these arrays.

In view of the lack of adequate written description for the claimed features discussed above, one of ordinary skill in the art would not be able to make or use the claimed invention without undue experimentation necessary to implement these features.

17. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

18. Claims 4, 8, 14, 16 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 recites the limitation "said firmware" in line 2 of limitation (b). There is insufficient antecedent basis for this limitation in the claim. In the interest of compact prosecution, the Examiner subsequently interprets "said firmware" as --said SCSI firmware and SCSI servo firmware-- for the purpose of further examination.

Regarding claim 8, the parenthetical phrase "(USERMAINTREQUEST)" renders the claim indefinite because it is unclear whether the limitation within parentheses is part of the

Art Unit: 2122

claimed invention. See MPEP § 2173.05(d). In the interest of compact prosecution, the Examiner subsequently ignores the aforementioned parenthetical phrase for the purpose of further examination.

Claim 8 recites the limitation “said SCSI firmware and SCSI servo firmware” in lines 4-5 of limitation (b) and again in lines 1-2 of limitation (c). There is insufficient antecedent basis for this limitation in the claim. In the interest of compact prosecution, the Examiner subsequently interprets “microcode firmware” in limitation (a) as --SCSI firmware and SCSI servo firmware-- for the purpose of further examination.

Claim 14 recites the limitation “said SCSI firmware data” in line 1 of limitation (d) and again in line 1 of limitation (e). There is insufficient antecedent basis for this limitation in the claim. In the interest of compact prosecution, the Examiner subsequently interprets “said SCSI firmware data” as --said SCSI firmware-- for the purpose of further examination.

As per claim 16, limitations (d), (g), (i), and (j) each end with the open-ended limitation “and if YES” (“if YES” in limitation (i)). It is unclear whether the “YES” in all of these phrases is intended to refer to the parenthetical assignments of “YES” and “NO” in limitation (d) or to the individual deciding, determining, and comparing steps recited in limitations (d), (g), (i), and (j). Further, as a semicolon follows each “if YES” limitation, it is unclear which, if any, subsequent steps are to be performed in response to a “YES”.

Art Unit: 2122

As per claim 17, the phrase “wherein step (d) is NO” renders the claim indefinite because “NO” is not a valid method step. In the interest of compact prosecution, this limitation is interpreted as “wherein the result of said deciding in step (d) is deciding not to download said firmware file to said peripheral controller”. However, based on the discussion of claim 16 above, it is unclear from the subsequent recitation of “and if YES” in limitation (d) of claim 16 whether any of steps (e) through (r) are cancelled by such a decision in limitation (d). Additionally, claim 17 suffers similar problems to claim 16 in that the phrase “if YES then” is recited in each of limitations (dn1), (dn5), (dn7), and (dn9). It is unclear whether the “YES” in all of these phrases is intended to refer to the parenthetical assignments of “YES” and “NO” in limitation (d) of parent claim 16 or to the individual deciding, comparing, inquiring, and checking steps recited in limitations (dn1), (dn5), (dn7), and (dn9). Further, as a semicolon follows each “if YES” limitation, it is unclear which, if any, subsequent steps are to be performed in response to a “YES”.

19. In view of the problems found in claims 16 and 17, as discussed above, the Examiner can form no meaningful interpretation or opinion of patentability, in view of prior art, for claims 16 and 17 in their present form. Lack of a rejection based on prior art for these claims should not be construed as an indication of impending allowability of these claims.

Art Unit: 2122


Conclusion

20. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Eric B. Kiss whose telephone number is (703) 305-7737. The Examiner can normally be reached on Tue. - Fri., 7:30 am - 5:00 pm. The Examiner can also be reached on alternate Mondays.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Tuan Dam, can be reached on (703) 305-4552. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EBK / EBK
March 4, 2004



TUAN DAM
SUPERVISORY PATENT EXAMINER